

**AMENDMENTS TO THE DRAWINGS**

Please amend the drawings by entering the enclosed Replacement Sheets for Figures 8 and 9.

**REMARKS**

This is a full and timely response to the above-identified non-final Office Action of October 13, 2004. The present amendment amends claims 2 and 7 in order to further clarify a portion of the scope sought to be patented, and otherwise disputes certain findings of fact made in connection with the rejection of the claims. Support for these amendments can be found variously throughout the specification, including, for example, original claims 1 and 6. No new matter has been added. Reexamination and reconsideration of the application in light of the following remarks are requested.

**Priority acknowledgement**

It is noted with appreciation that the certified copies filed in support of the claim for priority have been acknowledged in this first action.

**Specification, Title and Drawings**

The specification for this application has been reviewed and minor changes made thereto so as to correct a number of minor errors and so as to conform the specification to the drawings. No new matter has been introduced. This review was undertaken to prepare this application for final printing in view of the indication of allowable subject matter, and to respond favorably to the request by the Examiner for cooperation in reviewing the lengthy specification for error correction.

It is noted that the drawings as filed are accepted. Replacement Sheets are attached this Amendment so as to correctly identify Figures 8 and 9 as "PRIOR ART". Entry of these corrected Figures is respectfully requested.

In response to the request of the examiner, a new title is proposed supported by the preamble of claims 1 and 6, for example, to read -DATA SLICE CIRCUIT SEPARATING DATA ADDED TO A SIGNAL SUPERPOSED ON A VIDEO SIGNAL BASED ON A SLICE LEVEL-. If this revised title is not apt in the view of the examiner, he is invited to propose an alternative to his liking for prompt consideration.

Information Disclosure Statement and Art Cited

Receipt is acknowledged of two initialed PTO-1449 forms and of the PTO-892 Form showing the art considered and made of record by the examiner.

Pending claims

Claims 1 to 10 are pending in this application as filed. Claims 2 to 5 and 7 to 10 were indicated to be allowable. Accordingly, these allowable claims have been revised as a set to include the subject matter of their respective base claims 1 and 6. Thus, amended claims 2 to 5 and 7 to 10 are allowable over the art of record.

Claims 1 and 6 were initially rejected as unpatentable over Berman in view of Tufts '423. This rejection is respectfully traversed. The proposed combination is insufficient to provide a *prima facie* basis for the obviousness rejection of claims 1 and 6 because an insufficient motivation to combine the references is provided as a finding. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *See, e.g., In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported either by teachings in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a *prima facie* case. *See, e.g., In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

At the outset, it is noted that the findings of fact as to Berman and Tufts are not well-mapped to the specific recitations of claims 1 and 6. As set forth in MPEP § 1208, in explaining a rejection, the examiner shall compare at least one of the rejected claims feature-by-feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art as appropriate. While locations are reasonably well stated, the limitations of the claim for which the reference is cited is not apparent.

Consequently, it is somewhat difficult to determine what elements of Berman and Tufts '423 are alleged to correspond to the elements claimed in claims 1 and 6. For example, Berman is alleged to disclose a window pulse generation technique involving

averaging, perhaps taking into account the showing in Fig. 7c at line 21, where the data slice level is about midway of the amplitude of the superposed signal. Indeed, it was helpful in understanding the position of the examiner to refer to all of the section captioned “DATA SLICER” at column 10, line 44 to column 12, line 12.

But, when so considered, it is still not clear what elements in Berman the examiner contends meet the respective limitations of claims 1 and 6; namely, of “changing a period for generating the pulse by the specifications of the superposed prescribed signal”, as in the third full paragraph of the elements stated in claim 1. Nor is it completely clear, without impermissible speculation and guessing by the undersigned, as to how Berman is alleged to meet the limitation of “changing the direct current voltage to be added in accordance with the line detected by the line detection circuit”, as recited in the terminal portion of claim 1, for example. Still further, it is unclear which elements of claims 1 and 6 are not taught by Berman in a way requiring supplementation by citation to Tufts ‘423.

That deficiency makes it difficult to ascertain whether Tufts ‘423 is alleged to resolve all of the deficiencies of Berman’s teachings relative to claims 1 and 6. Thus, the rejection on its face is unclear as to whether all of the limitations of claims 1 and 6 are met by the combination, assuming that it is properly motivated or suggested. If not, a § 103 rejection fails for not meeting with the stated combination all of the recited limitations.

Finally, the findings on motivation are not well suggested by either Berman or Tufts’ 423 for incorporation of the teachings of Tufts ‘423 in Berman. Indeed, if Berman, for example, is deficient in meeting the “window pulse generation circuit” as claimed, nothing in Berman – except perhaps impermissible hindsight based on the Applicant’s disclosure – suggests or motivates the use of the teachings of Tufts’ 423. Nowhere in Berman is there a fair suggestion or teaching to one of skill in this art to refer to Tufts’ 423 for the feature claimed without reference to the Applicant’s disclosure. Indeed, the stated reasons for making the combination are more in the nature of a technical wish list that reasons for looking to Tufts for modification of Berman. *See In re Lee*, 277 F. 3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002)

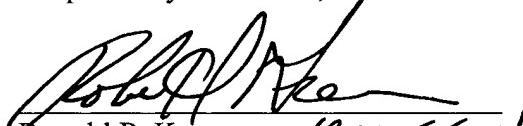
Accordingly, in light of the above, withdrawal of the rejection of claims 1 and 6 is requested. If the rejection is maintained, it is requested that the elements of claims 1 and 6 be mapped in accordance with the clear precedent of the Federal Circuit and Board and Appeals.

**CONCLUSION**

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2334 from which the undersigned is authorized to draw.

Respectfully submitted,

  
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Attachments: Replacement Sheets